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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,000	02/26/2002	Paul M. Cosenza	12912-002001	4287
26161	7590	08/10/2005	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			SMITH, KIMBERLY S	
			ART UNIT	PAPER NUMBER
			3644	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/083,000

Applicant(s)

COSENZA, PAUL M.

Examiner

Kimberly S. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The Applicant's request for reconsideration dated 06/27/05 has been reviewed. The Applicant's arguments are persuasive and a final action on the merits follows.

Response to Arguments

2. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claims 2-4 and 8-15 are objected to because of the following informalities: the preamble of these claims are not consistent with the preamble of the independent claim as currently amended. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forte, US Patent 5,249,310.

Forte discloses a protection system for used during outside activities comprising a protection element and a set of clothing articles (column 4, lines 1-2) donned by the person to be

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protected. While it is not positively stated, it is notoriously well known that typical street dress includes articles of clothing having a waist band, shirt collar, shirt front, shirt long sleeves and long pant cuffs. Forte discloses a protection element having an elongated substrate having a first inner adhesive layer and a second outer adhesive layer (as the protection element 14 is disclosed to comprise double sided tape). However, Forte does not disclose the use of a set or protection elements defining the corresponding clothing openings. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use more than one protection element, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. Forte discloses that the purpose of the protection element (14) is to provide a barrier means to prevent ticks and other insects from crawling into contact with trousers and skin (column 3, lines 34-42). As Forte discloses that the protection element is used to protect the wearer from ticks coming into contact with the skin, one with skill in the art would find it obvious to place the protection element at any location where ticks are known to have access to the skin inclusive of any clothing opening, including of shirt sleeves, shirt collars, waist bands and shirt fronts.

6. Claims 2-4 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forte, US Patent 5,249,310 as applied to claim 1 above, and further in view of Sekula, US Patent 3,816,956.

Forte as modified discloses the invention substantially as claimed. However, Forte does not disclose the protection device including an inner and outer release sheet mounted to the adhesive surface. Sekula teaches within the same field of endeavor the use of inner and outer release sheets mounted to the adhesive surface for preventing the tape from adhering to any

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structure other than those to which they are intended (column 1, lines 12-16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the inner and outer release sheets as taught by Sekula with the device of Forte as modified in order to prevent the protective element from sticking to other structures and to maintain them in a clean state prior to use.

Regarding claims 8-9, Forte as modified discloses the device as claimed. As the protection element is of a definitive length and definitive shape, it is considered pre-configured for its functional purpose.

Regarding claim 10, Forte discloses the invention substantially as claimed (reference discussion of claim 2 for obviousness rationale regarding the combination of Sekula). As can clearly be seen in Sekula, the protection element has the form of a roll.

Regarding claim 11, Forte discloses the invention substantially as claimed (reference discussion of claim 2 for obviousness rationale regarding the combination of Sekula). As can be clearly seen in Sekula, Figure 3, the protection element has the form of a sheet (defined as a portion of something that is thin in comparison to its length and breadth).

7. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forte as applied to claim 1 above, and further in view of Luria et al., (Luria) US Patent 5,381,557.

Forte discloses the invention substantially as claimed. However, Forte does not disclose the protection element comprising a shield portion. Luria teaches within the same field of endeavor the use of a shield portion (13) for the protection element for protecting the adhesive surface by sheltering it (column 4, lines 65-66). It would have been obvious to one having ordinary skill in the art to use the shield portion as taught by Luria with the protection element

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disclosed by Forte in order to protect the adhesive surface of the protection element. It is noted that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art.

Regarding claim 13, Forte as modified by Luria teaches the device as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the shield portion an integral extension of the substrate, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Regarding claim 14, Forte as modified by Luria teaches the shield portion being downwardly curved and extending outwardly (as seen in Figure 6 of Luria).

Regarding claim 15, Forte as modified by Luria teaches the shield portion being a protrusion from the second outer surface of the substrate (as viewed in Figure 6).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly S. Smith whose telephone number is 571-272-6909. The examiner can normally be reached on Monday thru Friday 10:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TERI PHAM LUU
SUPERVISORY
PRIMARY EXAMINER

Kimberly S Smith
Examiner
Art Unit 3644

kss